

Doc Code: AP.PRE.REQ

PTO/SB/33 (09-08)

Approved for use through 10/31/2008. OMB 0651-0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

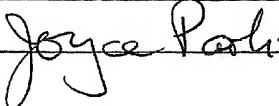
PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

9400-44

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]
on October 2, 2008

Signature



Typed or printed name Joyce Paoli

Application Number

10/646,962

Filed

08/25/2003

First Named Inventor

Wei Zhao

Art Unit

2617

Examiner

Un C. Cho

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

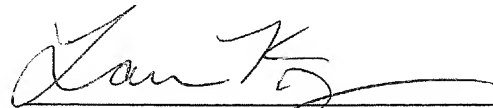
☒

attorney or agent of record.
Registration number 48,441

☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____



Signature

Laura M. Kelley

Typed or printed name

919 854 1400

Telephone number

October 2, 2008

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

☒

*Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application: Wei Zhao et al	Confirmation No.: 3021
Application No.: 10/646,962	Group Art Unit: 2617
Filed: August 25, 2003	Examiner: Un C. Cho
For: METHODS, SYSTEMS AND COMPUTER PROGRAM PRODUCTS FOR DIRECTING A USER TO A WIRELESS NETWORK ACCESS POINT	

Date: October 2, 2008

Mail Stop AF
Commissioner for Patents
Box 1450
Alexandria, VA 22313-1450

**REASONS IN SUPPORT OF APPLICANTS'
PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Sir:

This document is submitted in support of the Pre-Appeal Brief Request for Review filed concurrently with a Notice of Appeal in compliance with 37 C.F.R. 41.31 and with the rules set out in the OG of July 12, 2005 for the New Appeal Brief Conference Pilot Program, which was extended until further notice on January 10, 2006.

It is not believed that an extension of time and/or additional fee(s) is due. However, if any fee or extension of time for this request is required, Applicants request that this be considered a petition therefor. The Commissioner is hereby authorized to charge any additional fee which may be required, or credit any refund, to our Deposit Account No. 50-0220.

REMARKS

Applicants hereby request a Pre-Appeal Brief Review (hereinafter "Request") of Claims 1-7, 9 and 11-22, which stand finally rejected under 35 USC §103(a) over U.S. Patent Application Publication 2005/0203873 to Gray ("Gray") in view of U.S. Patent Application Publication 2004/0203890 to Karaoguz ("Karaoguz") and in view of U.S. Patent Application Publication 2004/0204071 to Bahl ("Bahl"). Applicants respectfully submit that one or more elements needed for a *prima facie* rejection under 35 USC §103(a) are not present.

Therefore, Applicants respectfully request review of the present application by an appeal

conference prior to filing of an Appeal Brief. In the interest of brevity, and without waiving the right to argue additional grounds should this Request be denied, Applicants will point out the Action's omission of one or more essential elements needed for a *prima facie* rejection.

Independent Claims 1, 17 and 20 are patentable over Gray, Karaoguz and Bahl

Claim 1 recites a method for directing a mobile user to a wireless network access point including:

- receiving a mobile user request for a location of a wireless network access point via a user terminal, wherein the user request comprises one or more amenities including one or more of a hotel, a restaurant, a store, a park and an airport;

- identifying a geographic location of the mobile user responsive to receiving the user request; and

- identifying a wireless network access point convenient to the user that provides access to the one or more amenities based on stored data including the physical location or address of a wireless network and the amenities available at or near the wireless network;

- wherein the user request includes a particular service provider associated with the wireless network and identifying a wireless network access point further comprises identifying a wireless network access point provided by the particular service provider.

Independent Claims 17 and 20 include recitations similar to Claim 1. The Action concedes that Grey does not disclose that the user request includes one or more amenities including one or more of a hotel, a restaurant, a store, a park and an airport. The Action cites Karaoguz as disclosing these features at paragraphs [0035]-[0037] and paragraph [0041]. The Action further states that Bahl discloses identifying a wireless network access point provided by a particular service provider at paragraphs [0038]-[0039] and paragraph [0045].

Applicants respectfully disagree with the Action's characterization of the cited references and submit that certain recitations of the independent claims are not disclosed or rendered obvious by Grey, Karaoguz and Bahl. In particular, Applicants submit that the cited references do not disclose that the user request includes one or more amenities including one or more of a hotel, a restaurant, a store, a park and an airport or identifying a wireless network

access point convenient to the user that provides access to the one or more amenities based on stored data including the physical location or address of a wireless network and the amenities available at or near the wireless network. In addition, the cited references do not disclose that the user request includes a particular service provider associated with the wireless network and identifying a wireless network access point further includes identifying a wireless network access point provided by the particular service provider.

With respect to Karaoguz, Applicants submit that Karaoguz does not disclose a user request that includes amenities including one or more of a hotel, a restaurant, a store, a park and an airport. Although Karaoguz discusses that the wireless telephone service provider can provide information "about the services offered by and capabilities of the nearby hotspots on a basis of more than distance" (*see* paragraph [0036] (cited in the Action)), the services and capabilities of the hotspots are apparently related to the offerings of the hotspot itself and not the amenities that are located nearby, *i.e.*, hotels, restaurants, stores, parks or airports. For example, Karaoguz discusses that the capabilities of the hotspot can include "voice, data and video networking capabilities, as well [as] the amount of bandwidth available to users of the hotspots." *See* paragraph [0036] (cited in the Action). As another example, Karaoguz discusses that a sports fan with the ability to receive streaming data might receive an advertisement detailing the presence of a streamed sporting event at a local hotspot. *See* paragraph [0037] (cited in the Action). However, Karaoguz does not discuss any amenities including one or more of a hotel, a restaurant, a store, a park and an airport as recited in Claim 1. This recitation is also not disclosed by Grey or Bahl.

Accordingly, Applicants submit that none of the cited references disclose or render obvious identifying a wireless network access point convenient to the user that provides access to the one or more amenities based on stored data including the physical location or address of a wireless network and the amenities available at or near the wireless network or that the amenities include one or more of a hotel, a restaurant, a store, a park and an airport.

In addition, Applicants submit that Bahl does not disclose that the user request includes a particular service provider associated with the wireless network and that identifying a wireless network access point further includes identifying a wireless network

access point provided by the particular service provider as maintained in the Action. It is noted that Claim 1 also recites identifying a wireless network access point convenient to the user that provides access to the one or more amenities based on stored data including the physical location or address of a wireless network and the amenities available at or near the wireless network.

Bahl proposes a method for establishing wireless data sessions between wireless clients, each of which support multiple wireless protocols. A commonly supported wireless protocol is utilized to share the wireless protocols supported by the clients' circuitry, and a wireless data session is then established based on the common capabilities of the wireless clients. Where multiple common protocols are supported, user preferences are utilized to determine which of the commonly supported protocols will be utilized. *See* Abstract. Bahl also discusses that the user preferences can include the preferred service provider support. *See* paragraph [0045] (cited in the Action). When the additional user preferences are taken into account, additional negotiations between the wireless clients may be required before a wireless data session is established. *See* paragraphs [0046] – [0047].

Therefore, the user preferences in Bahl are used to determine which protocol should be used for establishing a data session between wireless clients that support multiple protocols. Accordingly, Bahl uses the user preference to identify a protocol for a data session, and Bahl does not relate to identifying a wireless network access point convenient to the user that provides access to the one or more amenities based on stored data including the physical location or address of a wireless network and the amenities available at or near the wireless network. Bahl also does not disclose that the user request includes a particular service provider associated with the wireless network and that identifying a wireless network access point further includes identifying a wireless network access point provided by the particular service provider.

For at least the reasons discussed above, Claims 1, 17 and 20 and Claims 2-7, 9, 11-16 and 21-22 depending therefrom are patentable over Grey, Karaoguz and Bahl.

Attorney Docket No. 9400-44
Application Serial No. 10/646,962
Filed: August 25, 2003
Page 5

Applicant submits that one or more elements needed for a *prima facie* rejection under 35 USC §103(a) are not present. Therefore, Applicant respectfully requests that the present application be reviewed and reversed by the appeal conference prior to the filing of an appeal brief.

Respectfully submitted,



Laura M. Kelley
Registration No.: 48,441

USPTO Customer No. 39072
Myers Bigel Sibley & Sajovec
Post Office Box 37428
Raleigh, North Carolina 27627
Telephone: 919/854-1400
Facsimile: 919/854-1401

CERTIFICATION OF TRANSMISSION

I hereby certify that this correspondence is being transmitted via the Office electronic filing system in accordance with § 1.6(a)(4) to the U.S. Patent and Trademark Office on October 2, 2008.

Signature: Joyce Paoli
Joyce Paoli